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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,157	09/29/2003	Kejitan Jockey Dontas	13436.278 (Dontas 1-1)	1908
24283	7590	02/06/2007	EXAMINER	
PATTON BOGGS 1660 LINCOLN ST SUITE 2050 DENVER, CO 80264			KEEFER, MICHAEL E	
			ART UNIT	PAPER NUMBER
			2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,157	<b>Applicant(s)</b> DONTAS ET AL.	
	<b>Examiner</b> Michael E. Keefer	<b>Art Unit</b> 2109	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. This Office Action is responsive to the Application filed 9/29/2003.

#### *Specification*

2. The disclosure is objected to because of the following informalities:

On page 6, line 32, the number "321" should be deleted and replaced with the number --322--.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 1**, which is directed to a network address translation system. In order for claimed subject matter to be statutory, it must have a useful, concrete, and tangible result. In this case, the result is useful and concrete, but it is not tangible. The mere act of assigning an IP address does not store anything, nor does it make any information available to a user.

**Claims 2-4**, which is dependent on claim 1 adds no tangible result to the system and so is rejected for the same.

Regarding **claim 5**, which is directed to a method using network address translation. In order for claimed subject matter to be statutory, it must have a useful, concrete, and tangible result. In this case, the result is useful and concrete, but it is not

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tangible. The mere act of assigning an IP address does not store anything, nor does it make any information available to a user.

**Claim 6-8**, which is dependent on claim 5 adds no tangible result to the system and so is rejected for the same.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 4 and 8**, which claim that if a data transmission is sent from the Protocol Engine (PE) to the Function Management System (FMS), the PE's private IP address should be appended as the destination address for the data transmission. This would in effect cause the PE to be unable to communicate with the FMS, as all transmissions it would attempt to send to the FMS would be rerouted back to the PE.

The examiner's interpretation of the claim is that the PE's private address was meant to be appended as the source address for the data transmission.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over The applicant's admitted prior art drawing Figure 5 in view of Bhatia et al. (US 6023724), hereafter Bhatia.

Figure 5 discloses:

A network address translation system (Fig. 5) for isolating internal IP traffic from external IP traffic in the Inter-Working Function of a Global System for Mobile Communications network (Fig. 5, 301), comprising:

network means for interconnecting (Fig. 5, Ethernet Switch 314) an Inter-Working Function Protocol Engine (Fig. 5, 312) and an Inter-Working Function Management System (Fig. 5, 311), located in said Inter-Working Function;

external IP address means for assigning said port of said Inter-Working Function Protocol Engine with a public IP address for access from a source located external to said Inter-Working Function (321, since the address has been assigned, means for assigning are inherent);

L2TP network server means (303) connected to said network means (314) for interconnecting said network means with the Internet. (Fig. 5)

Admitted prior art Figure 5 discloses all of the limitations of claims 1-3 and 5-7 except for internal IP address means, routing means, and address means for appending.

Regarding the missing limitations, Bhatia teaches:

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internal IP address means for assigning a port of said Inter-Working Function Protocol Engine with a private IP address for use exclusively on said network means; (Col 11, lines 59-62 state that LAN modem 300 assigns a private address to both terminals 10e and 10f)

routing means for assigning a one of said private and public IP addresses to data transmissions received at said network means and associated with said port of said Inter-Working Function Protocol Engine. (Col 12, lines 10-25 describe the routing means that assign IP addresses to data transmissions received.)

address means for appending said assigned public IP address to said data transmission as a source address when said port of said Inter-Working Function Protocol Engine is a source of said data transmissions for transmission to said L2TP network server means. (Col 12 lines 17-23 discloses that packets heading to the ISP have their address changed (appended) to use the public IP address.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the admitted prior art of Figure 5 to include the use of the IP address means, routing means and address means of Bhatia in order to significantly reduce time and costs associated with establishing, configuring and using a LAN for a workgroup as well as with connecting each client therein to a remote network service provider.

(Bhatia, Col 4, lines 27-30)

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8. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted Prior Art Figure 5 and Bhatia as applied to claims 1-3 and 5-7 above, and further in view of Warriar et al. (US 2002/0116523), hereafter Warriar.

Prior Art Figure 5 and Bhatia teach all the limitations of claims 4 and 8 except for:

address means for appending said assigned private IP address to said data transmission as a destination address when said port of said Inter-Working Function Protocol Engine is a source of said data transmissions for transmission to said Inter-Working Function Management System. (Note examiner's interpretation in the above 112 rejection.)

The general concept of assigning a source address to a data packet based on the destination of the data packet is well known in the art as taught by Warriar. (Fig. 3, steps 307-317)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the admitted Prior Art Figure 5 and Bhatia with the general concept of assigning a source address to a data packet based on the destination of the data packet as taught by Warriar in order to reduce round trip time by allowing the destination if in the same private network to respond directly within the private network without having to have the request routed through the public network.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Keefer whose telephone number is (571)

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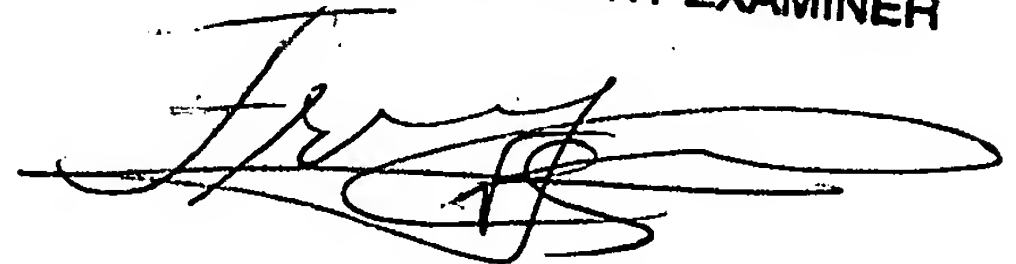
270-1591. The examiner can normally be reached on Monday-Thursday 8am-5pm, second Fridays 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on (571) 270-1808. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 1/30/2007

FRANTZ JULES  
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to be 'Frantz Jules', written over a horizontal line.